REMARKS/ARGUMENTS

The office action mailed October 13, 2006 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested. Claims 1-15, 30-44, 55-69 are currently pending.

The 35 U.S.C. § 103 Rejection

Claims 1-15, 30-44, 55-61, and 62-69 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Walker et al. (USP 6,110,041) in view of Walker et al. (USP 6,077,163) and Microsoft®Windows®95 among which claims 1, 30, and 62 are independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.) §2143,

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.**

Office Action Contentions

Specifically, the office action contends, with regard to independent claims 1, 30, and 62 that the elements of the presently claimed invention are disclosed in Walker '041 except that Walker '041 does not teach "a simulated game presentation, wherein the simulated game presentation is for allowing a user to determine the effects of different game feature settings on the game presentation prior to initiating wagering game play on the gaming machine wherein the wager is not required to view the simulated game presentation."

The office action cites Microsoft®Windows®95 as teaching the above feature and that states that it "would be obvious to one having ordinary skill in the art at the time of the applicant's invention to incorporate features taught by Microsoft®Windows®95 [into] Walker's gaming

machine. One would be motivated to do so in order to see how the player selected preferences will look on the screen prior to actually saving the player selected preference." The office action also states that the "combination of the Walker references with the Windows reference would be obvious because Windows is an operating system for use in many electronic devices, which comprises a master controller, memory, input device, and user interfaces, much like the ones disclosed in the Walker references. Further, there is sufficient motivation to combine because the Walker references disclose the use of a preference selection menu ..., therefore it would be obvious to combine the teachings of the Windows preference selection menu with that of Walker."

The office action further states "the Windows reference teaches a preference selection menu wherein the user is able to change the display properties on the display to their own preference. ... In the device of Walker, the settings must be saved prior to playing the wagering game; therefore, no wager is necessary for the user to preview the simulated game presentation in the combination of the references." Applicants respectfully disagree for the reasons, among others, set forth below.

Brief Description Of Invention

As stated in the many previous responses, the present invention describes, as recited in claim 1 for instance, a gaming machine comprising a master gaming controller that is designed or configured to control one or more games played on the gaming machine and to request preference account information from a remote server wherein each game played on the gaming machine comprises a) receiving a wager an outcome for the game, b) determining the outcome for the game and c) displaying a game presentation of the outcome determined for the game; and a user interface configured to display preferences, to receive preference selections, to display a simulated game presentation of a game of chance available for wagering game play on the gaming machine, and to display information regarding one or more preferences in a group of available preferences. The simulated game presentation is for allowing a user to determine the effects of different game feature settings on the game presentation for the game of chance prior to initiating wagering game play on the gaming machine where the wager is not required to view the simulated game presentation.

There is no Suggestion or Motivation to Combine the Reference Teachings

"Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teachings or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *In re Dow Chem. Co.*, 837 f.2d 469, 473 5 USPQ 1529, 1531 (Fed. Cir. 1988). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). "The test is not whether one device can be an appropriate substitute for another," rather, an examiner "must make specific findings establishing why it was 'apparent' to use" the combination of the prior arts. *Ruiz v. A.B. Chance Co.*, Fed. Cir., No. 99-1557 (December 2000).

"The notion . . . that combined claims can be declared invalid merely upon finding similar elements in separate prior art patents would necessarily destroy virtually all patents and cannot be the law under the statute, §103." *Id.* Furthermore, though the examiner "can theoretically explain the technicalogical rationale for the claimed invention using selected teachings from the references. This approach, however, has been criticized by our reviewing courts has hindsight reconstruction." *Ex parte Obukowicz*, 27 USPQ2d 1063 (B.P.A.I. 1992) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed . Cir. 1988)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention'" *Id.*, 23 USPQ2d 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Neither Walker nor the Windows reference suggests or mentions "a simulated game presentation of a game of chance available for wagering game play on the gaming machine" as claimed. The Windows reference does not mention or suggest in any manner the simulated game presentation, game presentations of any type, wagering game play of any type or determining the effects of game feature settings prior to initiating wager game play. Walker does not teach or suggest the simulated game presentation or determining the effects of game feature settings prior to initiating

simulated game presentation or determining the effects of game feature settings prior to initiating wager game play. Moreover, Walker does not describe any need to determine the effects of different game feature settings on the game presentation prior to initiating wagering game play on the gaming machine and the Windows reference makes no mention of gaming or wagering game play. If the Examiner continues to maintain this rejection, it is respectfully requested that the Examiner specifically cite where, in the prior art references, the suggestion to combine the references to obtain "a simulated game presentation of a game of chance available for wagering game play on the gaming machine" may be found. Neither prior art references suggest the desirability for the modification to obtain the claimed feature.

Accordingly, there is no motivation or suggestion to combine the prior art references to obtain the claimed invention. Rather, such a motivation has been given by the applicant who first realized the problems presented and discovered a viable solution. Using the applicant's teaching to modify a prior art reference is an impermissible use of "hindsight." *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

There Is No Reasonable Expectation of Success that the Combination of the Reference Teachings will Result in the Claimed Invention

The office action states "the Windows reference teaches a preference selection menu wherein the user is able to change the display properties on the display to their own preference. ... In the device of Walker, the settings must be saved prior to playing the wagering game; therefore, no wager is necessary for the user to preview the simulated game presentation in the combination of the references." Applicants respectfully disagree as the alleged combination of Walker and the Windows reference would still require a wager for a player to preview the simulated game presentation.

The alleged combination of the prior art references results in a gaming machine whereby the settings are saved prior to playing the wagering game, as stated by the Examiner. However, a player will not be able to preview or determine the effects of different game feature settings without making a wager. In Walker, the player is required to make a wager and play the game to see the effects of any selected features on the game - Walker does not teach or suggest otherwise. As such, the alleged combination of Walker and the Windows reference would result in a gaming machine that allows a player to save settings but still requires a wager to see the effects of the

selected features on the game. The alleged combination of the prior art references do not allow "a user to determine the effects of different game feature settings on the game presentation prior to initiating wagering game play on the gaming machine where the wager is not required to view the simulated game presentation" as claimed in Claim 1. Thus, there is no reasonable expectation of success that the combination of the references will result in the claimed invention.

The Prior Art References do Not Teach or Suggest All the Claim Limitations

For the reasons discussed above, the alleged combination of the prior art references do not teach or suggest all the claim limitations. Namely, as discussed above, neither Walker nor the Windows reference teach "a user interface configured to display preferences, to receive preference selections, to display a simulated game presentation of a game of chance available for wagering game play on the gaming machine, and to display information regarding one or more preferences in a group of available preferences, wherein the simulated game presentation is for allowing a user to determine the effects of different game feature settings on the game presentation for the game of chance prior to initiating the wagering game play on the gaming machine wherein the wager is not required to view the simulated game presentation" as claimed in Claim 1.

Accordingly, since there is no suggestion or motivation to combine reference teachings, there is no reasonable expectation of success that the combination of the reference teachings will result in the claimed invention, and the prior art references do not teach or suggest all the claim limitations, they can not be said to render the claimed invention obvious. Additionally, as to dependent claims 2-15, 31-44, 56-69, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable. In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Request for Entry of Amendment

Entry of this Amendment will place the Application in better condition for allowance, or at the least, narrow any issues for an appeal. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited and Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Since this case has been pending since August 6, 2002 and has undergone several requests for continuations, if a Notice of Allowance is not granted, Applicant respectfully and formally hereby requests an interview with the Examiner to expedite prosecution of this application.

It is believed that no fees are required, however, the Commissioner is hereby authorized to charge any additional fees, including any extension fees, which may be required or credit any overpayment directly to the account of the undersigned, No. 50-0388 (Order No. IGT1P026).

Respectfully submitted,
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